

REMARKS

This responds to the Office action mailed May 10, 2004.

\* Enclosed is the required fee of \$110.00 for a one-month extension.

Applicants request reconsideration of the rejection of claims 1, 8, 12, 13, 16, 19, 20, 25, 26, 30, 31, 34, 37, and 38 under § 103(a) as being unpatentable over Eustice 3,915,729.

Claim 1 has been amended to include the requirement previously presented in claim 8, namely, that the branch point on the fatty acid lubricant additive is at the second carbon position.

A requirement to establish obviousness under §103 is stated as follows:

... the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP 2143. Emphasis added.

Including a fatty acid lubricant additive which is branched at the second carbon position is an affirmative requirement of applicants' claim 1 and cannot be ignored in assessing patentability. Obviousness is not established here because Eustice fails to disclose or suggest this requirement. Moreover, the Office action does not assert that this requirement is disclosed or suggested anywhere in the cited references.

A further requirement to establish obviousness is stated as follows:

... there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine the reference teachings. MPEP 2143.

The Office action has not pointed to any motivation to modify the Eustice composition and method to employ a fatty acid lubricant having a branch point at the second carbon position, and in fact no such motivation is provided by the cited art. Accordingly, claim 1 is not rendered obvious.

Claim 8 has been cancelled.

Claims 12, 13, 16, 19, and 20 depend from claim 1 and are therefore patentable for the same reasons as claim 1.

Claim 25, like claim 1, has been amended to include the requirement previously presented in claim 26, namely, that the branch point on the fatty acid lubricant additive is at the second carbon position. Claim 25 is therefore patentable for the same reasons as claim 1, i.e., because the cited references fail to disclose or suggest this requirement.

Claim 26 has been cancelled.

Claims 30, 31, 34, 37, and 38 depend from claim 25 and are therefore patentable for the same reasons as claim 25.

With regard to the rejection of claims 10, 11, 28, and 29 over Eustice 3,915,729 in view of Hirata et al., these claims have been cancelled, rendering this rejection moot.

Applicants note that claims 9 and 27 were stated to be allowable if rewritten in independent form. This has been done. No new claim fees are believed to be due because extra claim fees of \$396 were paid upon filing the application.

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CONCLUSION

In view of the foregoing, applicants request issuance of a Notice of Allowability for claims 1, 9, 12, 13, 16, 19, 20, 25, 27, 30, 31, 34, 37, and 38.

Respectfully submitted,



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\*Enclosure

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